

### **REMARKS**

This amendment is submitted in reply to the Office Action dated February 5, 2007. Claims 11-36 currently stand rejected. Applicant has amended independent claims 11, 16, 31 and 33-36 to more particularly distinguish the claimed invention from the cited references. Newly added claim 37 has been added to further define patentable aspects of the invention. No new matter has been added by the amendment.

In light of the amendment and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

#### **Claim Rejections - 35 USC §101**

Claims 33, 35 and 36 currently stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicants have amended independent claim 33 to more clearly be directed to statutory subject matter. However, with respect to independent claims 35 and 36, Applicants respectfully traverse.

Independent claim 33 has been amended to recite that the previously claimed server includes a processing element that is configured to perform the corresponding previously claimed functions of independent claim 33. Accordingly, the claimed apparatus of independent claim 33 includes structure to perform the recited functions.

Independent claims 35 and 36 are directed means-plus-function claims. Applicants respectfully note that elements of a means-plus-function claim are construed based on the corresponding structure disclosed in the specification and equivalents thereof (*In re Donaldson*, 16 F.3d 1189, 29 U.S. P.Q2d (BNA) 1845 (Fed. Cir. 1994) and MPEP 2181). Moreover, the specification provides such structure for each corresponding element of the claimed invention. Accordingly, Applicants fail to see how independent claims 35 and 36, each reciting several means elements, which each have a corresponding function, could be non-statutory for failing to include structure. Indeed, by virtue of well known claim construction rules, the structure of independent claims 35 and 36 is provided by the specification. Accordingly, the claimed apparatuses of independent claims 35 and 36 include structure based on the specification and the well understood rules of claim construction in regards to means-plus-function claims.

Appl. No.: 09/746,270  
Amdt. Dated 05/04/2007  
Reply to Office Action Dated 02/05/2007

In light of the amendment to claim 33 and the remarks above, Applicants respectfully submit that the rejections of claims 33, 35 and 36 under 35 U.S.C. §101 are overcome.

**Claim Rejections - 35 USC §103**

Claims 11-36 currently stand rejected under 35 U.S.C. §103(a), as being unpatentable over Dusse et al. (U.S. Patent No. 6,647,260, hereinafter "Dusse").

Claims 11-30 are directed to methods for downloading media content. Independent claim 11 recites, *inter alia*, requesting media content from a mobile station, temporarily saving the media content within the mobile station, and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content. Thus, according to an embodiment as recited in independent claim 11, the same media content that is requested is temporarily saved. In other words the claimed invention requires that the media content that was requested in the initial operation is temporarily saved within the mobile station. Additionally, at least a portion of the media content that was specifically requested in the initial operation is also previewed on the mobile station. Applicants respectfully submit that Dusse fails to teach or suggest at least temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content as recited in independent claim 11.

The final Office Action alleges that the above-recited features are disclosed at col. 8, lines 35-47 of Dusse. Specifically, the final Office Action alleges that Dusse's disclosure of terms, conditions and related information being pushed to the mobile station meets the above recited features. This analysis is respectfully traversed.

Applicants respectfully note that the Office Action states at page 9 that Dusse discloses content and related notifications at col. 7, lines 60-62. The Office Action further states that Dusse discloses that "upon processing of a request from the mobile station, terms, conditions, and related notifications are pushed to the mobile station after approval by the user" at col. 8, lines 34-38. The Office Action therefore surmises that the terms, conditions and related

notifications must be temporarily stored within the mobile terminal until previewed by the user and that "media content" may be interpreted to include the terms, conditions and related notifications in addition to the content that was specifically requested. However, even if the reasoning expressed in the Office Action were assumed to be correct (an assumption Applicants expressly disagree with), Dusse still fails to teach or suggest the claimed features as currently recited.

In this regard, as presently expressed in independent claim 11, the previewed portion of the media content is itself specifically requested. To the contrary, the terms, conditions and related notifications of Dusse are not, as admitted by the Office Action, themselves specifically requested. Rather, the Office Action lumps the terms, conditions and related notifications, which the Office Action states are previewed, in with the actual requested content as "media content". However, the independent claim 11, as amended, provides that the previewed portion of the media content comprises a **specifically requested portion** of the media content. Thus, given that the terms, conditions and related notifications do not constitute a specifically requested portion of any media content, Dusse fails to teach or suggest previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a portion of the media content specifically requested as recited in independent claim 11.

Independent claims 16, 31 and 33-36 have been amended to incorporate similar subject matter to that of independent claim 11 at least with respect to the previewed portion of the media content comprises a portion of the media content specifically requested. Accordingly, independent claims 16, 31 and 33-36 are patentable for at least the same reasons given above for independent claim 11.

Despite the reasons given above for the patentability of the independent claims of the present application, Applicants respectfully note that some of the independent claims include yet further novel and nonobvious features with respect to Dusse. In this regard, independent claim 11 has also been amended to recite, *inter alia*, permanently saving the media content within the mobile station only when permission to save has been received **from the server**.

The Office Action alleges that the above recited feature is disclosed by Dusse at col. 7, lines 32-40 and col. 8, lines 35-47. However, col. 7, lines 32-40 of Dusse, only discloses saving content relating to device features and services that match requested features or services and there is no indication whatsoever in this passage of any requirement of receiving permission to save the content as recited in independent claim 11. The Office Action further asserts that col. 8, lines 35-47 of Dusse refers to user acceptance of the terms, conditions and related information, which the Office Action interprets as constituting "permission to save". However, as indicated above, independent claim 11 has been amended to clarify that the permission to save is received from the server. Accordingly, Dusse fails to teach or suggest permanently saving the media content within the mobile station only when permission to save has been received from the server as recited in independent claim 11.

Independent claims 16, 31 and 36 have also been amended to recite the aspect of permission being received from the server and are therefore patentable for the same reason given above for independent claim 11. Independent claims 33-35 are written from the perspective of the server and describe the provision of such permission to save to the mobile station, thereby serving as further evidence of the patentability of these claims as well. Thus, based on all the reasons stated above, independent claims 11, 16, 31 and 33-36 are neither anticipated nor rendered obvious in view of Dusse. Claims 12-15, 17-30 and 32 depend directly or indirectly from independent claims 11, 16 and 31, respectively, and thus include all the recitations of their respective independent claims. Therefore, dependent claims 12-15, 17-30 and 32 are patentable for at least the reasons given above for independent claims 11, 16 and 31.

Accordingly, for all the reasons stated above, Applicants respectfully submit that the rejections of claims 11-36 over Dusse are overcome.

#### **Newly Added Claim**

Applicants have added new claim 37 to more particularly define aspects of the present application. The new claim includes no new matter and is fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claim is in condition for allowance.

Appl. No.: 09/746,270  
Amdt. Dated 05/04/2007  
Reply to Office Action Dated 02/05/2007

**CONCLUSION**

In view of the amendment and remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Chad L. Thorson  
Registration No. 55,675

**Customer No. 00826**  
**ALSTON & BIRD LLP**  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Charlotte Office (704) 444-1000  
Fax Charlotte Office (704) 444-1111

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON MAY 4, 2007.  
LEGAL02/30351219v1